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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,803	08/27/2003	Marco Musaragno	66309-0182	3939

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Washington, DC 20005

EXAMINER

SMALLEY, JAMES N

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/648,803	Applicant(s) MUSARAGNO, MARCO	
	Examiner James N. Smalley	Art Unit 3727	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2006.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8, 9, 11-15 and 17-21 is/are pending in the application.
 4a) Of the above claim(s) 20 and 21 is/are withdrawn from consideration.
 5) ☒ Claim(s) 19 is/are allowed.
 6) ☒ Claim(s) 1-6, 8, 9, 11-15, 17 and 18 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 8-9, 11-15 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suter EP 629,559 in view of Ryder US 4,750,610.

Suter '559, in the embodiment of figure 5, teaches a synthetic cork, with a duct, and a tube located within the duct. The tube contains a filter, but it is not clear if the filter comprises microholes.

Ryder '610 teaches a hydrophobic filter (36) for a contact lens case, which is disposed within the duct of a synthetic tubular housing (34). In col. 4, line 37, the reference discloses the microholes have a diameter of 0.2 microns. In col. 4, lines 37-38, the reference teaches the filter is an acrylic copolymer anchored to a non-woven nylon fabric.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the filter of Suter '559, providing the membrane of Ryder '610 because the two are mechanical expedients equally capable of filtering air while preventing passage of liquid.

Regarding claims 5-6, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the body of any suitable material because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Allowable Subject Matter

3. Claim 19 is allowed.

Response to Arguments

Applicant's arguments filed 01 February 2006 have been fully considered but they are not persuasive.

a) Applicant argues the patent of Suter '559 does not teach a tube located in a duct.

Examiner notes the Applicant's arguments are drawn to benefits incurred in the manufacture of the invention, when the membrane is placed within a tube and then within a duct. However, Examiner notes the arguments are invalid because these benefits or manufacturing steps are not part of the claimed invention. Assuming *arguendo* that they were, Examiner notes the patentability of an apparatus claim with manufacturing steps is based on the degree to which those manufacturing steps materially affect the final product. It has been held that method limitations in a product claim do not serve to patentably distinguish the claimed product from the prior art. See *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). Thus, even though a product-by-process claim is limited and defined by a process, determination of patentability is based on the product itself. Accordingly, if the product in a product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process. *Thorpe*, 777 F.2d at 697, 227 USPQ at 966; *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983).

Examiner contends the tube of Suter '559 is integrally secured in the cork duct.

b) Applicant argues one of ordinary skill would not be lead to the contact lense case of Ryder.

Examiner notes both inventions are drawn to solving the same problem, that being venting of gas while preventing escape of liquids. Furthermore, Examiner notes oxygen permeability is two way in such membranes, in that oxygen is free to escape or enter. It is well known that regardless of the process involved, venting solutions are universally applied to various applicants because of a common desired benefit, that being venting of gas while preventing escape of liquid. US Patent 5,901,867 (Mattson) teaches this in column 1, noting: "Pressure can accumulate in containers from a variety of causes including gas evolving chemical reactions, de-gassing of filled contents..." The first two examples are drawn to the process in Ryder '610, and Suter '559, respectively. Therefore, Examiner asserts that

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regardless of the application, one of ordinary skill is drawn to solving the problem, that being filtered venting of gas. In this case, both patents are indeed relevant and the combination of the two would be obvious to one of ordinary skill.

Finally, Examiner notes a person having ordinary skill in the art is presumed to have knowledge of all of the relevant prior art in his field of endeavor, as if it were all hanging on his workshop walls. *Filmon Process Corp. v. Spellright Corp.*, 274 F. Supp. 312, 313, 155 USPQ 635, 636 (D.D.C. 1967), *aff'd*, 404 F.2nd 1351, 131 U.S. App. D.C. 374, 158 USPQ 533 (1968).

c) Applicant argues there is no evidence in Ryder '610 to support exchange of gas and oxygen.

Examiner asserts that by being permable to gas in one direction, a membrane inherently can allow for permeation in the return direction, depending on the difference in the concentrations of the gas on either side of the membrane, as taught by the fundamental laws of gas diffusion.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James N. Smalley whose telephone number is (571) 272-4547. The examiner can normally be reached on M-Th 9-6:30, Alternate Fri 9-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


NATHAN J. NEWHOUSE
SUPERVISORY PATENT EXAMINER

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